

**REMARKS**

Claims 1 through 59 are pending in this reissue application.

**I. Status of The Claims**

Claims 1 through 56 remain pending. Claim 20 is, according to Paper No. 41, withdrawn from consideration.

By this Amendment, claims 4, 5, 6, and 44 are amended.

Claim 7 is presented in its entirety incorporating a typographic omission that occurred in an earlier filed amendment.

Claim 44 is amended to re-write the paragraph “locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination” so as to read --locking said video signal by preventing application of said video signal to enable said mixing in dependence upon said determination— in view of the question raised by the Examining staff.

**II. Support for Claim Changes**

**Claims 4, 5 and 6**

Claims 4, 5 and 6 are amended to delete “tape” and thereby alter its preamble to more broadly read “video recorder”, and to substitute the generic phrase “storage medium” for “tape.” Support for these changes lies in the original text of patented claims 4, 5 and 6.

**Claim 7**

Claim 7, as pointed out by the Examining staff, contained a typographic omission. That omission has been corrected to insert the originally cited language inadvertently omitted from that claim in the previously filed Amendment. Specifically, the language “, and remaining in said system power standby mode of operation” was re-inserted at lines 4 and 5 of claim 7. Support for this change lies in the original text of claim 7.

**III. Incomplete Office Action Under 37 CFR §1.104**

In various telephone conversations with Applicant’s undersigned attorney, the Special Program Examiner (SPrE) stated that Paper No. 41 contained several factual and legal errors as well as erroneous conclusions, and admitted that “everybody has made mistakes.” A careful review of Paper No. 41 by Applicant’s undersigned attorney confirms the presence of the errors kindly noted by the SprE, as well as other factual and legal errors, and erroneous conclusions errors throughout Paper No. 41, and that Paper No. 41 lack the completeness required under 37 CFR §1.104(b) and (c). These “mistakes” permeate the entirety of Paper No. 41 to some degree. Clarification is respectfully requested in subsequent Office correspondence, and subsequently, Applicant understands that in view of these “fundamental defects” in Paper No. 41, the Examiner will review and reconsider the prosecution history, and if indicated, issue a non-final action pursuant to 37 CFR §1.104(a) and (b), with the requisite degree of completeness contemplated by 37 CFR §1.104(a) and (b). Despite the forthcoming clarification and Office correspondence, Applicant will endeavor to address each of the issues raised in Paper No. 41, to the extendable.

#### **IV. Election/Restrictions**

In Paper No. 41 the Examining staff concluded under 37 C.F.R. §1.176 Applicant had filed "No Disclaimer" with the reissue application and that therefore,

"the subject matter of the original patent claims will be held to be constructively elected. Accordingly, claim 20 is withdrawn from consideration is being directed to a non-elected invention. See 37 C.F.R. §1.142 (b) and MPEP §821.03."<sup>1</sup>

Applicant disagrees, and observes that the Examining staff has made a number of errors in its rationale given in support of its conclusion.

**First**, the Examining staff's reliance upon 37 C.F.R. §1.176 is false. In its entirety, 37 C.F.R. §1.176 as that section existed at the time of Applicant's 17 February 2000 filing date, and at the time of Applicant's filing of the Notice of Appeal, reads, in its entirety:

"An original claim, if re-presented in the reissue application, is subject to reexamination, and the entire application would be examined in the same manner as original application, subject to the rules relating there to, excepting that division will not be required. Application for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after announcement of the filing of the reissue application has appeared in the *Official Gazette*."<sup>2</sup>

37 C.F.R. §1.176 as quoted in Paper No. 41 is erroneous and is incorrect, as is demonstrated by the foregoing recitation. Consequently, Paper No. 41 is incomplete under 37 C.F.R. §1.104 (a) and (b). Confirmation of the presence of this "mistake" in subsequent co-written correspondence from the Examiner and the Special Program Examiner is respectfully requested, in order that Applicant's

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<sup>1</sup> Paper No. 41, page 3.

<sup>2</sup> 37 C.F.R. §1.176.

attorney may have full and fair opportunity to address the factual basis for this “mistake” and to conclude this compacted prosecution unhindered by the incompleteness and errors that plague Paper No. 41. Additionally, if there is a basis that precipitated this “mistake” by the Examining staff, the Examiner is respectfully requested to identify the source of that “mistake” in the written-qualification.

**Second**, 37 CFR §1.176 contains an express prohibition against “division” of reissue applications. There are no transitional rules for 37 CFR §1.176 , and there is no provision of 37 CFR §1.176 which applies the recent amendments of 37 CFR §1.176 retroactively. It would appear therefore, that to the extent that Paper No. 41 violated the prohibition against division, Paper No. 41 lacks the completeness demanded by 37 CFR §1.104(a) and (b).

**Third**, the Examining staff stated that reissue “claim 20 is directed to an invention that is independent or distinct from the invention originally claimed.” Claim 20 was timely presented in a preliminary amendment filed simultaneously with this reissue application. Under U.S. patent practice as established by the Code of Federal Regulations,

“[a] preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.”<sup>3</sup>

The clear import of 37 CFR §1.115(a)(1) would suggest that the statement made by the Examining staff,

“claim 20 is directed to an invention that is independent or distinct from the invention originally claimed”,

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37 CFR §1.115(b).

is false. Given the admission by the SprE for “Tech Center 3600” that everybody made mistakes, together with the presence of this “mistake” in Paper No. 41, Paper No 41 lacks the degree of completeness and accuracy required by 37 CFR §1.104(a), (b) and (c). Written clarification is respectfully requested. Additionally, the Examining staff is respectfully requested to identify the original of their statement that,

“claim 20 is directed to an invention that is independent or distinct from the invention originally claimed”,

and the circumstances which caused that statement to be written in Paper No. 41, in order that Applicant might have a full and fair opportunity to either respond, or contradict or explain the facts set forth in that written clarification.

**Fourth**, the Examining staff also alleges that claim 20 is directed to a process that is distinct from the apparatus claims of the original reissue claims of the patent since:

“the process may be practiced by another materially different apparatus such as a device that does not require any mixer, or rather the process may be practiced by a parent evaluating the box/case of a video tape to see its rating, prior to inserting the tape into a VCR the parent signaling to a child that the video is not appropriate, and upon telling the child it is not appropriate, barring the transmission of the video content by removing the tape from the vicinity of the VCR, the VCR having a conventional standby mode and playback mode of operation.”<sup>4</sup>

While this statement gives a clear recognition of the advantages of Applicant’s inventions over the state of the art, it does not justify a constructive election by the Applicant under the sole provision of the regulations which is applicable, namely 37 CFR §1.145 for the reason that claim 20 was

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<sup>4</sup>

Paper No. 41, page 2.

original to Applicant's reissue application.<sup>5</sup> Moreover, claim 20 has been examined on the merits, and has not be disclaimed by the Applicant. Consequently, absent any art applied to support a rejection of claim 20, there is no basis for not stating in subsequent Office correspondence that claim 20 is allowable over the prior art. Such action is respectfully requested.

**Fifth**, the Examining staff further wrote that claim 20 is:

“distinct from any of the method claims since the method claims do not require any subjective evaluation to generate a code.”<sup>6</sup>

This statement is unsupported by any authority. Moreover, nothing negates the practice of Applicant's invention in compliance with these excerpted features of claim 20. Most importantly, the language of claim 20, and any difference between that language and the language of any other claim is not the criterion established by either 37 CFR §1.141 or §1.145 for a restriction. The applicable criterion for restriction is the presence in one national application of “two or more independent and distinct inventions ... .” Here, Applicant has disclosed but a single embodiment, albeit with many features and numerous aspects, which may be practice in a plethora of ways and with a wide variety of circuits. Consequently, current Office practice is, as is fully explained by the *Manual*,

“[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention restriction therebetween should never be required. this is because the claims are but different definitions of the same disclosed subject

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<sup>5</sup> Under 37 CFR §1.115(b), a “preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.”

<sup>6</sup> Paper No. 41, page 2.

matter, varying in breath or scope of definition.”<sup>7</sup>

Under these mandatory instructions, the withdrawal of claim 20 from examination is improper, and examination of claim 20 is mandatory.

**Sixth**, the Examining staff continued in this vein by then asserting that:

“it is not seen where in the original specification such subjective evaluation is disclosed in a sufficient manner to meet the requirements of 35 USC 112 for someone skilled in the art to make and/or use such, particularly in light of the failure of the applicant to provide an explanation of the support in the disclosure for **changes made to the claims.**”<sup>8</sup>

Once again, the prosecution history of this application does not support the excerpted averment by the Examining staff, because, as is explained below, at the time of Applicant’s amendments, there was no requirement in any clause of what was then 37 CFR §1.173 which demanded that:

“an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims . . . , and an explanation of the support in the disclosure of the patent for the **changes made to the claims,**”

and 37 CFR §1.173(c) has no retroactivity. The Examining staff is invited, for its edification, to consider the state of U.S. law as of then applicable: *see*, especially 37 C.F.R. §1.173.

**Seventh**, Paper No. 41 raises serious constitutional questions. Independent of the then state of 37 CFR §1.173, Article I, Section 9 of the U.S. Constitution states that:

“No . . . *ex post facto* Law shall be passed.”

Paper No. 41 seeks however, to impose the provisions of regulations which were conceived long

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<sup>7</sup> *Manual of Patent Examining Procedure*, 8<sup>th</sup> Edition, Revision 2 (August 2001), §806.03.

<sup>8</sup> Paper No. 41, page 2.

after Applicant's amendments were made. The defining issue here is by what authority the Examining staff sought to act in writing Paper No. 41. Clarification is respectfully requested in subsequent Office correspondence to (i) identify by what authority the Examining staff sought to act in writing Paper No. 41 that:

“an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims ... , and an explanation of the support in the disclosure of the patent for the **changes made to the claims**”;

(ii) identify by what authority the Examining staff sought to act in writing Paper No. 41 that:

“it is not seen where in the original specification such subjective evaluation is disclosed in a sufficient manner to meet the requirements of 35 USC 112 for someone skilled in the art to make and/or use such, particularly in light of the failure of the applicant to provide an explanation of the support in the disclosure for **changes made to the claims**”<sup>9</sup>;

(iii) identify by what authority the Examining staff sought to act in writing Paper No. 41 that:

“claim 20 is ... distinct from any of the method claims since the method claims do not require any subjective evaluation to generate a code”;<sup>10</sup>

and (iv) state precisely the significance under that authority which the Examining staff attributes to each of the foregoing statements in Paper No. 41.

Applicant respectfully requests additional written clarification (vi) explaining the basis for making this statement in Paper No. 41, and (vii) stating that this is one of the “mistakes” referred to by the SprE in the various discussions about the “mistakes” by “Tech Center 3600” with Applicant’s

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<sup>9</sup> Paper No. 41, page 2.

<sup>10</sup> Paper No. 41, page 2.

undersigned attorney.

Accordingly, absent rejection of claim 20 on the merits, and with the withdrawal of earlier art rejections of claim 20, claim 20 is now deemed to be allowed. Confirmation of this is subsequent Office correspondence is respectfully requested.

#### **IV. Rejection of Claims 1-19, 21-43 And 59 Under 35 U.S.C. §101**

Claims 1 through 19, 21 through 43 and 59 are provisionally rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1 through 43 of co-pending U.S. Serial No. 10/337,364. The Examiner further stated in paragraph 2 on page 2 that the rejection can be overcome by canceling or amending the conflicting claims in the co-pending application.

Under current U.S. practice, as defined by §804 of the *Manual of Patent Examining Procedure*, May 2003,

“If the ‘provisional’ double patenting rejection in one application is the only rejection remaining in the application, the Examiner should then withdraw that rejection and permit the application to issue as a patent ... .”

At the time of the filing date of Applicant’s co-pending application, all of claims 1 through 43 in that application, and claims 1 through 19, 21 through 43 and 59 in this application were allowable. It is noted that the sole issue of merit in this application is this provisional double patenting rejection, the remaining issues are present due to what the Special Program Examiner identified as “mistakes.” The Examiner is therefore requested to remove the “provisional” double patenting rejection and to pass this application to issue. There is neither need nor necessity to cancel claims in Applicant’s

patent application Serial No. 09/506,288 at this time, in view of the admission by the Examining staff of the errors in the previous rejections, and the concomitant completion of the appeals process without the necessity of a hearing before the Board of Patent Appeals and Interferences of the U.S. Patent & Trademark Office.

Moreover, the *MPEP* makes no such threshold requirement for withdrawal of this provisional rejection. Should Applicant's co-pending application proceed to allowance upon completion of the pending appeal, these copied claims could then be timely cancelled from the parent application.

## **V. Defective Amendment**

### **i) Amendment at the Time of Filing**

The Amendment made at the time of filing the reissue application was objected to as not being in compliance with 37 CFR §1.173(c). Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, the Examining staff wrote,

"[t]he amendments are incomplete since according to 37 CFR §1.173(c) there is no explanation of the support in the disclosure of the patent for the changes made to the claims according to 37 CFR §1.173(c). An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with 37 CFR §1.173(b)-(e) and (g); see *MPEP* §1453."<sup>11</sup>

These statements are incorrect and untimely, and contribute significantly to the incompleteness

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<sup>11</sup>

Paper No. 41, page 3.

which permeates Paper No. 41.

The Examining staff's attention is invited to the filing date of the present reissue application, that is, 17 February 2000. At the time of filing the present reissue application, there is no section §1.173(c) in 37 C.F.R., and there was no requirement in any clause of what was then 37 CFR §1.173 which demanded that:

“an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims . . . , and an explanation of the support in the disclosure of the patent for the changes made to the claims.”

The Examining staff is invited, for its consideration, to *see* the text of 37 C.F.R. §1.173 set forth in, for example, the Federal Intellectual Property Laws and Regulations, 2000 Edition and 2001 Edition. Moreover, nothing in 37 CFR §1.173(c) indicates a retroactivity whereby amendments filed prior to the effective date of 37 CFR §1.173(c) become, *ipso facto* “incomplete” under 37 CFR §1.173(c). The allegation made in Paper No. 41 that “[t]he amendment are incomplete” lacks the gravity and degree of completeness demanded under 37 CFR §1.104(a), (b) and (c); written clarification in subsequent Office correspondence is therefore respectfully requested in order to accord Applicant a full opportunity to make an considered response. Specifically, in subsequent non-final Office correspondence, the Examining staff is requested to (i) identify the words of 37 CFR §1.173(c) that makes an amendment filed prior to the effective date of 37 CFR §1.173(c) applicable to that amendment; (ii) identify the words of 37 CFR §1.173 in force of law as of the filing dates of Applicant’s amendment which makes any amendment filed by Applicant “incomplete” under those words; (iii) identify the clause of statute or regulation which makes 37 CFR §1.173(c)

retroactive in its application, and (iv) to specifically state why the Examining staff has procrastinated until the 24<sup>th</sup> of June 2005 to levy an allegation of “incomplete” against those Amendments.

Withdrawal of the objection to the Amendment made at the time of filing the reissue application is therefore required.

## **VII. Rejection Of Claims 44-58 Under First Paragraph Of 37 C.F.R. §112 – Enablement**

In paragraph 22 of Paper No. 41, claims 44 through 58 are rejected under the *first* paragraph of 35 U.S.C. §112 as allegedly “failing to comply with the enablement requirement.” In support of this rejection, the Examiner argued that

“[t]he claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art ... to mark and/or use the invention.”<sup>12</sup>

This rejection and the conclusion given by the Examining staff in support of this rejection, are unsupported by evidence in the record.

In support of this rejection the Examining staff wrote that,

“claims 44, 48, 55 and 56 set forth a process wherein a first lock key data signal is received and a second lock data key signal is received after the first lock key data signal, such receiving times being separated by an interval ... .”

It is unclear here whether the Examining staff is referring to the sequential input of lock key data signals illustrated by Figure 3A or to the successive input of lock key data signals illustrated by

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<sup>12</sup>

Paper No. 41, page 10.

Figure 3B. In either event, this process is found in the progression of process steps 11 through 17 illustrated by Figure 1. Applicant notes however, that “receiving times being separated by an interval” is not language found in claims 44, 48, 55 or 56. Clarification in subsequent Office correspondence is respectfully requested. In view of the clear demonstration of enablement in the originally filed application of the inventions actual defined by claims 44, 48, 55 and 56, this rejection is unfounded; its withdrawal and allowance of claims 44 through 58 is respectfully requested.

**VIII. Rejection Of Claims 44-58 Under First Paragraph Of 37 C.F.R. §112 – Written Description**

In paragraph 23 of Paper No. 41, claims 44 through 55 are further rejected under the *first* paragraph of 35 U.S.C. §112 as allegedly containing subject matter which was not described in the specification. In support of this rejection, the Examiner asserted that:

“[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art ... that the inventor(s) at the time the application was filed, had possession of the claimed invention. Claims 44, 48, 55 and 56 are insufficiently disclosed in the specification as originally filed.”<sup>13</sup>

This rationale is inadequate to support a rejection under the written description requirement of the first paragraph of 35 U.S.C. §112. Applicant therefore respectfully traverses this rejection, and requests its withdrawal.

**First**, the reasoning given by the Examiner in support of this rejection is rather convoluted,

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<sup>13</sup> Paper No. 41, page 10.

and appears to turn upon the language of claim 5, but the interpretation of that language cited by the Examiner is a paraphrase of claim 5, and that paraphrase is incomplete. Moreover, that paraphrase is not language which appears in claim 5. As demonstrated below, the use of a garbled version of a claim by the Examining staff is improper, and is inadequate to support a rejection under the written description requirement of the first paragraph of 35 U.S.C. §112.

**Second**, it is highly unorthodox to apply the language of claim 5 to support a rejection of claims 44, 48, 55 and 56 under the written description requirement of the first paragraph of 35 U.S.C. §112. Each claim necessarily differs.

**Third**, the Examining staff asserts that,

[c]laim 5 ... added a limitation of generating first and second control outputs for a period of time defined by ... [but] the specification does not provide an enabling disclosure for such limitation particularly in light of the fact that in each instance of receiving a lock key data signal, video is reproduced or received and displayed ... .”<sup>14</sup>

This rationale of the Examining staff is factually incorrect; not only has this issued already been addressed by the Board of Patent Appeals and Interferences, but neither claim 44, 48, 55 nor 56 use language such as “generating first and second control outputs for a period of time” or “in each instance of receiving a lock key data signal, video is reproduced or received and displayed.” Accordingly, there is no basis for maintaining this rejection. Its withdrawal is respectfully requested.

**Fourth**, the Examining staff writes that,

“there is no support in the specification as originally filed for determining a match of first and second lock key data signals ... .”

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<sup>14</sup>

Paper No. 41, page 10.

Perhaps the Examining staff should consider Applicant's Figure 1, steps 15 or 16, among other teachings of Applicant's original specification. In view of this, there is no basis for maintaining this rejection. It withdrawal is respectfully requested.

#### **IX. Rejection Of Claims 44-58 Under Second Paragraph Of 37 C.F.R. §112**

In paragraph 24 of Paper No. 41, claims 44 through 58 are also rejected under the *second* paragraph of 35 U.S.C. §112 as being allegedly indefinite. Applicant addresses each instance of indefiniteness alleged in the following paragraphs.

##### **Claim 44**

Paper No. 41 states that,

"The language 'locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination' is indefinite and fails to clearly and distinctly set forth the invention. What is the difference between 'locking said video signal' and 'preventing application of said video signal'? The language 'preventing application of said video signal to enable said mixing' is contradictory since 'preventing application of said video' and the 'enabl(ing) said mixing' appear contradictory."<sup>15</sup>

It is unclear why the Examiner has divided the ultimate paragraph into two clauses, and has not read the ultimate paragraph of claim 44 as it is written, in a single clause; when read in its entirety, claim 44 is accurate and definite. The Examiner has however, dissected the ultimate paragraphs of claim 44 and then questioned,

"[w]hat is the difference between *locking said video signal* and

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<sup>15</sup>

Paper No. 41, pages 11 and 12.

*preventing application of said video signal to enable said mixing?"<sup>16</sup>*

As written, claim 44 defines a process comprised of, among other features,

"mixing said video signal and said first character signal; ... mixing said video signal and said second character signal ...[and] locking said video signal and preventing application of said video signal to enable said mixing ... ."

The short answer to the Examiner's question is that *locking said video signal* is one part of one possible implementation of Applicant's process and *preventing application of said video signal to enable said mixing* is another part. A more complete answer dwells upon the fact that a "mixer" is not a node; timing is everything in video signal processing because the basic property of a mixer 'is that its output is not directly proportional to its input, but to the product of its inputs; when signals of different frequencies are applied to such a device, the output contains not only the original frequencies but also frequencies equal to the sum and difference of the original frequencies."<sup>17</sup> In a general definition, a "mixer" is a circuit "in which two or more signals are combined."<sup>18</sup> In video circuits, a "video mixer" is a circuit that "allows video images to be combined and creates sophisticated translations between scenes."<sup>19</sup> With most signals applied to a mixer, the phases and the synchronization of the signals applied to the mixer are important. With a video mixer, in the NTSC system used in the United States and in Japan, there are thirty frames per second, and thus

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<sup>16</sup> Paper No. 41, pages 11 and 12.

<sup>17</sup> Bartleby.com, *The Columbia Encyclopedia*, 6<sup>th</sup> Edition, 2001-05.

<sup>18</sup> Bartleby.com, *The Columbia Encyclopedia*, 6<sup>th</sup> Edition, 2001-05.

<sup>19</sup> focusinfo.com, *Mixing Video Sources: Digital Video – Focus Enhancements*, 4 October 2005.

sixty fields per second, while in extended definition (EDTV) and in high definition (HDTV) there are several hundred lines per frame. The time base of the video signal determines when each line, each field, and each frame begins. A clear, steady picture, devoid of jumpy images, flagging or waving verticals, requires an accurate, unchanging time base because if the lines start early or late, the visual video image will shift or waver in various ways; the wiggles in the video image are time-based errors. Two distinct video signals obtained from different sources are unlikely to be synchronized. When combining two or more video signals for example, one signal can not start at line 55 while the second signal subsequently begins at line 1; the image will be unviewable. Moreover, with HDTV, absent precise synchronization, and with pixel addressed flat screen displays such as thin-film-transistor (TFT) or plasma display screens, because the video signals are binary (*i.e.*, in the vernacular, “digital”) signals, the visual display driven by the combined video signals will be illegible. A mixer assures time-base corrections and frame synchronization, typically with sufficient memory to store part of the video pictures. One technique of mixing uses the vertical and horizontal synchronization signals derived from one video signal to control the combination of two signals, such as a video signal and an on-screen character generator. Devices such as that disclosed by Rew ‘085 however, deliberately avoid combining video signals, and have no need of a mixer because they experience no problems of time-base correction or of line or frame synchronization.

Although the rationale given in Paper No. 41 for this rejection is unclear, Applicant has amended claim 44 to change the paragraph “locking said video signal and preventing application of said video signal to enable said mixing in dependence upon said determination” so as to read -- locking said video signal by preventing application of said video signal to enable said mixing in

dependence upon said determination– in view of the question raised by the Examining staff.

**Claim 47**

Paper No. 41 asserts that claim in 47,

“the language ‘locking said audio signal and releasing said muted video signal in dependence upon’ the determination of whether a second lock key data signal is identical to a first lock day data signal is not clear since it is not understood why the audio would be locked and the video would be unlocked”.<sup>20</sup>

It is unclear whether the Examiner has considered that as disclosed in Figure 2 of Applicant’s original specification, Applicant’s invention may be practiced with separate audio processing circuit stage 104 and video processor circuit stage 103; or that these stages 103, 104 may, in one implementation of Applicant’s invention, practiced with different video mute circuit unit 107 and audio mute circuit unit 108; or that a video mute control signal is applied via lead 9 and an audio mute control signal may be applied via a different lead 10. A question of indefiniteness may not be predicated upon an artificial dissection of the language of the claim, because the claim must be read in its entirety. Clarification is subsequent Office correspondence is respectfully requested in order that Applicant will be able to fairly respond. Absent clarification, it is sufficient to note that audio processing circuit stage 104 and video processor circuit stage 103, or video mute circuit unit 107 and audio mute circuit unit 108, or a video mute control signal applied via lead 9 and an audio mute control signal applied via a different lead 10 need not be simultaneously in identical states; consequently, there is no indefiniteness present in claim 47, and there is no basis for maintaining this

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<sup>20</sup>

Paper No. 41, page 11 and 12.

rejection.

### **Claims 50-52 And 58**

Paper No. 41 stated that,

“the determination of whether the second lock key data is identical to a reference and the subsequent changing of the locking/unlocking state in dependence thereon is not clear since the ‘reference’ is undefined and not specified in the specification”.<sup>21</sup>

It is unclear whether the Examiner is arguing for a proposition that the express language of each claim be found *verbatim* in the specification. Not only is there is no support for this proposition in either the statute or the Code of Federal Regulations, but the second paragraph of 35 U.S.C. §112 does not require that each and every claim contain only those nouns found in the specification.

Although this rejection is couched in terms of claims 44 through 58 “being indefinite” and as “failing to particularly point out and distinctly claiming the subject matter which applicant regards as *the* invention,”<sup>22</sup> the rationale given by Paper No. 41 is not written in these terms, but is rather written in terms questioning the breath and scope and of claims 44 through 58. The term “reference” is self-defining, and is used in parallel with “the second lock key data” and “identical”; the relationship between “the second lock key data” and “reference” is well defined, precise and inescapable in its meaning and clarity in this passage; any additional verbiage in this claim directed to the “reference” would concomitantly limit the scope of coverage provided by claims 50 through

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<sup>21</sup> Paper No. 41, page 12.

<sup>22</sup> Second paragraph of 35 U.S.C. §112.

52 and 58 .

Moreover, in presenting this argument in support of an indefiniteness of claims 50 through 52 and 58 the Examiner is arguing that the scope of Applicant's claims must each conform completely and exactly to the embodiments disclosed in the specification, without regard to the fact that under the statute, the specification and claims serve distinctly diverse offices. Under the second paragraph of 35 U.S.C. §112, no restriction is placed upon the scope of the Applicant's claims; the sole restriction placed upon the claims is that the claims particularly point out and distinctly claim:

“the subject matter which *the applicant* regards as his invention”.<sup>23</sup>

It appears that this rejection is premised upon the Examiner's belief that the language of each claim must be identical to the other claims, that no generic term be used to describe a species detailed in the specification, and that each passage of a claim have antecedent basis in the language of the specification; this is not U.S. practice and Paper No. 41 cites no authority for this proposition.<sup>24</sup>

In summary, these rejections of claim 44 through 58 under the second paragraph of 35 U.S.C. §112 raise no question about whether the Applicant here has particularly pointed out and distinctly claimed the subject matter which the Applicant regards as his invention; whether each claim is written to use only nouns printed in some part of the specification is immaterial to questions under

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<sup>23</sup> Second paragraph of 35 U.S.C. §112.

<sup>24</sup> The Examiner's attention is invited to note that under the second paragraph of 35 U.S.C. §112, Congress has bestowed upon solely *the applicant*, and not upon the Commissioner or upon the Examiner, the prerogative of determining the “the subject matter *which he regards* as his invention.”

the second paragraph of 35 U.S.C. §112. Once the specification satisfies the criteria of the first paragraph of §112, the breadth of the claims is left under 35 U.S.C. §102 and §103, to the state of the art as that art existed at the time of Applicant's invention. Here however, Paper No. 41 has questioned the definiteness of claims 44 through 58 on grounds that the language of these claims is not identical to the specification and that the language of claims 44 through 58 differs from the language of the other pending claims; this observation does not however, raise a question of whether claims 44 through 58 are "claims particularly pointing out and distinctly claiming the subject matter which *the applicant* regards as his invention".<sup>25</sup> Consequently, there is no basis in the record for continuing this rejection. Its withdrawal is respectfully requested.

#### X. Question About Claim 59

Paper No. 41 raised one question about claim 59, but made no rejection of claim 59. That question asked whether the definition of "a locked state" written in line 11 is inconsistent with the placement of the "barring of viewing" when the determination of line 10 establishes that the "on-screen display system is not in said locked state"? Lines 10 through 12 are in fact consistent with lines 14 through 16. Perhaps the Examining staff should think of lines 10 through 12 as providing antecedent basis for lines 14 through 16, rather than as the occurrence of successive, or alternative, occurrences; viewed in another context, lines 10 through 12 would be diagramed with a conditional diamond while lines 14 through 16 would be diagramed as a rectangular process step. Consequently, no inconsistency is present.

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<sup>25</sup> Second paragraph of 35 U.S.C. §112.

**XI. Rejection of Claims 7, 9-19, 27-43 and 59 Under 35 U.S.C. §103(a)**

Claims 7, 9 through 19, 27 through 43 and 59 were rejected under 35 U.S.C. § 103 (a) as rendered obvious, and unpatentable over the Examining staff's proposed combination newly cited Rew U.S.C. Patent No. 5,033,085 filed on the 27<sup>th</sup> June 1988, modified according to the newly cited Inagaki *et al.* U.S. Patent No. 4,896,354 filed on the 11<sup>th</sup> of October 1985. Applicant respectfully traverses these rejections for the following reasons.

The primary reference, Rew'085, contemplates that when,

“no code is set up in the television set, the television set is driven normally by pressing the power key only as in the conventional way”<sup>26</sup>

and that,

“in a state that a code is set up in the television set, the television set is not driven normally when the power key is pressed ... [] there is displayed a code set-upstate, and then as a key signal corresponding to the code is input, the code set-upstate displays is released and at the same time, the video and audio signals of the television broadcaster are output normally.”<sup>27</sup>

The secondary reference, Inagaki *et al.* '354, teaches a character generator 6, a blanking or masking circuit 7 for superimposing a masking signal on the video signal received from the video detector 3 on the basis of command data drive from microcomputer 7, in order to thereby blank the video signal. Mixing circuit 8 mixes the character information from the character generator and display

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<sup>26</sup> Rew'085, column 1, lines 32-35.

<sup>27</sup> Rew'085, lines 36-44.

controller 6 together with the output from the masking circuit 7.<sup>28</sup>

**A. The rejection of claims 7, 9 through 19, 27 through 43 and 59 fails to make a *prima facie* showing of obviousness under 35 U.S.C. §103(a)**

This rejection of claims 7, 9 through 19, 27 through 43 and 59 fails to meet the criteria of the Office for a *prima facie* showing of obviousness under 35 U.S.C. §103(a). According to MPEP 706.02(j), the criteria for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 mandates that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Applicant respectfully suggests that none of these criteria has been met by Paper No. 41.

**Claims 7, 9 and 27**

In support of this rejection the Examining staff urged that:

“Rew operates such that during a power standby mode, a power key signal input is entered by the keyboards/remote controller (3: §7-4:3). This power key input meets the scope of the claim *lock key* or *lock*

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<sup>28</sup>

Inagaki *et al.* ‘354, column 2, lines 34-45.

*key data.”<sup>29</sup>*

The Examining staff has ignored paragraphs 10 through 18 and 20 through 27 of the decision of the Board of Patent Appeals and Interferences (Paper No. 35) entered only the 22<sup>nd</sup> of July 1997, appeal No. 95-1187, which constitutes the administrative record and law of this application. The holding of the Board and its reasoning may not be summarily dismissed by the Examining staff and a misguided effort to reconstruct the art in light of Applicant’s claims. Specifically, in Applicant’s parent application the Board expressly considered what is now pending claims 7, 9 and 27, which recites, among other features,

“Checking for a key-data input signal from said keyboard or remote control during a system power standby motive operation until said checking step identify said key-data input signal as being indicative of an input from said lock key ...,”<sup>30</sup>

and,

“responding to input signals selectively input ... by controlling production of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a secret code and a second input of said lock key data followed by said secret code ... .”<sup>31</sup>

These features are not met by the Examining staff’s proposed combination; instead, the manipulation of “this power key input” takes the Examining staff’s proposed combination out of the scope of claims 7, 9 and 26. Nothing in the secondarily reference cures this deficiency in the proposed

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<sup>29</sup> Paper No. 41, page 5.

<sup>30</sup> Claims 7 and 27.

<sup>31</sup> Claim 9.

combination, because Inagaki'354 uniformly initiates his "code registration" and "code verification", as well as his "block channel registration" with "a normal television picture" being displayed as shown in figure 4 of Inagaki'354. Consequently, the Examining staff's proposed combination fails to make a *prima facie* showing of Applicant's process set forth in claims 7 and 26. Withdrawal of the rejection therefore is required. Moreover, the failure to consider the express finding of the Board negates any suggestion of obviousness under 35 U.S.C. §103 (a).

### **Claims 9 and 15**

Unlike the Examining staff's proposed combination, Applicant's claims 9 and 15 defines, *inter alia*,

a:

"[m]icrocomputer responding to inputs signals selectively input ... by controlling production of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a secret code and a second input of said lock key data followed by said secret code ... ."

This, in combination with Applicant's "mixture generating said video components by mixing said first video signal and said second video signal" can only be found in the Examining staff's proposed combination through an impermissible hindsight reconstruction of the art in light of the blueprint provided by Applicant's claim 9. In fact, this is what the Examining staff has done by asserting that:

"the masking circuit (7) and mixing circuit (8) provides a substantially equivalent function (erase/mute audio/audio signals when locked) and substantially equivalent environment (video system and TVR CTV) for a substantially equivalent purpose (to providing

control over viewable media) to the switching element of Rew,”<sup>32</sup>

and that:

“[i]t would’ve been obvious ... to modify Rew by substituting a conventional masking circuit/mixing circuit for the switching element in Rew as taught by Inagaki et al. in order to effectively blank the video/audio signals from the output terminal of the video system and prevent viewing programs considered harmful ... since the masking/mixing circuit provides advantage of the capability to simultaneously display video as well as on-screen character data, such a channel or time information, when both video and character data are available.”<sup>33</sup>

Contrarily to the admonition of §706.02(j) of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Edition, Revision 2, the Examining staff has provided absolutely no “suggestion or motivation either reference themselves or the knowledge generally available to one of the ordinary skill of art, to modify” the primary reference according to Inagaki’354 to incorporate the masking circuit 7 and mixing circuit 8. Moreover, the teaching in the primary reference expressly negates any need for such a modification, because the primary reference, as illustrated in the enclosed modification of figures 1 and 2,

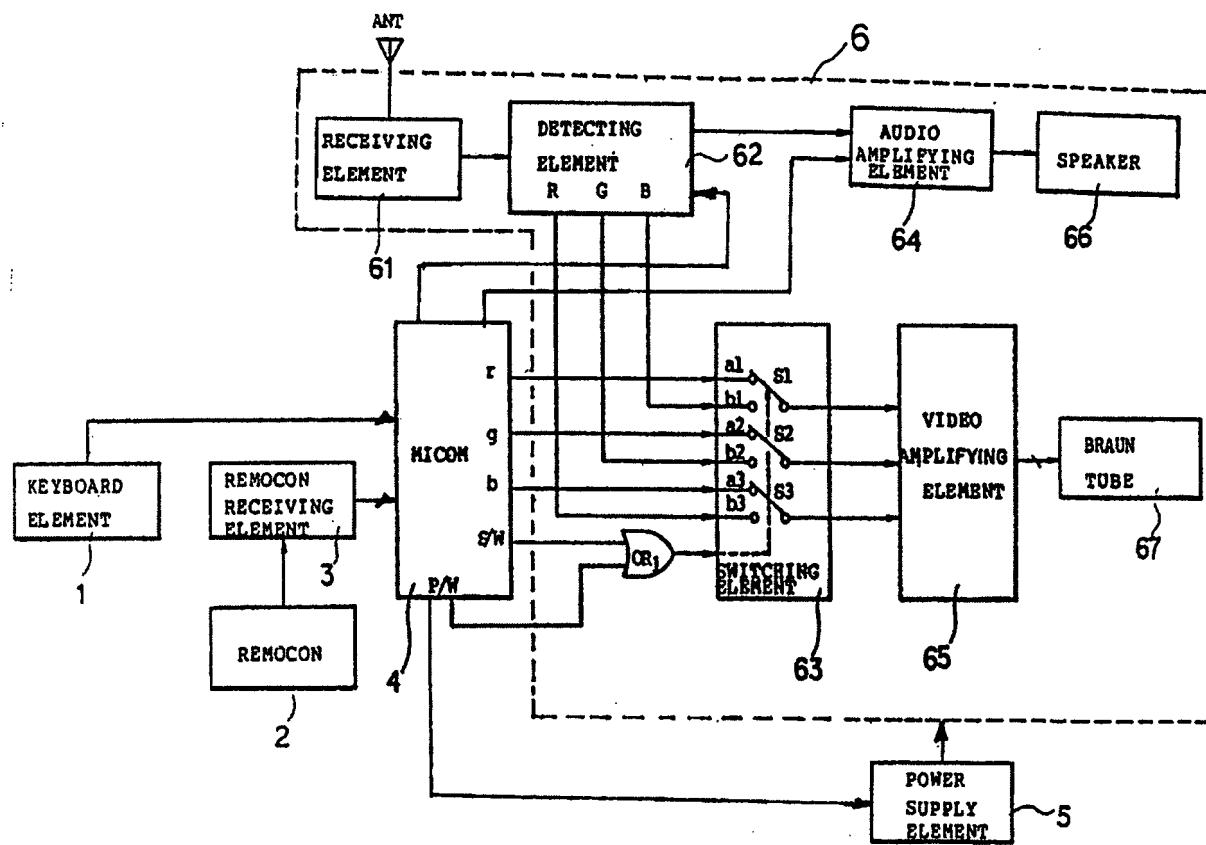
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<sup>32</sup> Paper No. 41.

<sup>33</sup> Paper No. 41, page 8.

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FIG. 2



uses microcomputer 4 to create its “On-Screen character display on the Braun tube” as is demonstrated by figure 3 (A), and by figures 4 and 5. Not only is this proposed modification of the primary reference unsupported by evidence of motivation for making the modification, the modification unnecessary and produces a useless circuit. **First**, the primary reference teaches by a single video signal, namely the R,G,B video passed by “detecting element 62” and applied to “video amplifying element 65” via “switching element 63.” A “mixing circuit 8” mixed two, or more, video signals such as the output of “detector 3” and “character generator 6” of Inagi ‘354. Recognizing that the primary reference uses but one video signal, precisely what two video signals do the Examining staff’s proposed combination mix? Clarification is respectfully requested in subsequent Office correspondence. **Second**, the Examining staff has ignored the express teachings of the primary reference, which intends to operate in a very specific mode of denying any and all “unauthorized use of a television set.”<sup>34</sup> This is a different mode of operation from Applicant’s “video system.” Specifically, Rew ‘085 operates in its denial of any and all “unauthorized use of a television set” with the result that:

“if a code N1 is set up ... microcomputer 4 outputs an audio erasing signal so that no audio signal is output from the audio amplifying element 64, and also outputs the video erasing and switching signals so that the switches S1-S3 of the switching element 63 are *short circuited* ... and *at the same time* the ON screen character display signals output from the microcomputer 4 are displayed on the Braun tube 67 through the switching element 63 and the video amplifying element 65.”<sup>35</sup>

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<sup>34</sup> See, by way of example, the especially apt characterization of the intended mode of operation of Rew ‘085 stated in the preambles of its claims 1 through 3.

<sup>35</sup> Rew ‘085, column 3, lines 17-24.

Consequently, there is no need to “mix” any video signals, or to use a “mixing circuit 8” from the secondary reference, or to make any other modification of the primary reference in order to obtain the absolute denial of any and all “unauthorized use of a television set” intended by the primary reference because, as explained by the primary reference,

“the video and audio erasing signals are, thereafter, output *at the same time* the switching signals are output ... .”<sup>36</sup>

Unlike the primary reference, Inagaki ‘354 contemplates the use of “mixer circuit 8” in its “reception block” mode of operation, to accommodate, among video signals, a video display of “OUT BAND DATA such as an emergency broadcast data and so on from the front end 1” as well as frequency shift data from “FSK 9”,<sup>37</sup> this is unnecessary and undesired in the primary reference.

Furthermore, the modification proposed by the Examining staff would impermissibly prevent the primary reference from operating in its intended mode of operation, with,

“any person who does not know the code [being] unable to drive the television set”<sup>38</sup>.

The sole video image displayed on the Braun tube is provided by r,g,b signals provided by “Microm 4” through switching element 63, which in the teachings of the primary reference, not only avoids the possibility of an external source of a video signal being applied directly to mixing circuit 8, as is demonstrated by Applicant’s figure 2, in order to circumvent the blocking circuit and generate a

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<sup>36</sup> Although in this passage Rew ‘085 is discussing his sequence for resetting the code, the statement is uniformly applicable to all of the operations performed by Rew ‘085.

<sup>37</sup> Inagaki ‘354, column 2, lines 41-49.

<sup>38</sup> Rew’085, column 4, line 64.

video signal on the television receiver, but displays only a single image at any one time by the simple expedient of designing a circuit in which:

“the microcomputer 4 outputs an audio erasing signal so that no audio signal is output from the audio amplifying element 64, and also outputs the video erasing and switching signals so that the switches S1-S3 of the switching element 63 are short circuited to terminals a1-a3 on one side and the same time the On screen character display signals are output.”<sup>39</sup>.

Without the Examining staff’s proposed combination, either surreptitious efforts to circumvent the blocking aspect of the primary reference may not be reliably prevented due to the presence of a mixing circuit which may, in essence, be employed as a port for unauthorized video signals from another source such as a video cassette player or a DVD player, a risk that is prevented due to the absence of a mixing circuit 8 in the blocking scheme of the primary reference, or alternative sources of video signals such Inagaki ‘354’s contemplated the use of “mixer circuit 8” in its “reception block” mode of operation, to accommodate, among video signals, a video display of “OUT BAND DATA such as an emergency broadcast data and so on from the front end 1” as well as frequency shift data from “FSK 9”<sup>40</sup>, all of which would readily defeat the absolute denial of any and all “unauthorized use of a television set” intended by the primary reference with:

“any person who does not know the code [being] unable to drive the television set”<sup>41</sup>.

This incorporation of masking circuit 7 and mixing circuit 8 from Inagi ‘354 into the primary

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<sup>39</sup> Rew ‘085, column 3, lines 18-24.

<sup>40</sup> Inagaki ‘354, column 2, lines 41-49.

<sup>41</sup> Rew’085, column 4, line 64.

reference neglects to consider that the intended mode of operation of the primary reference is stated to be:

“[a]ccordingly, the video signals output from the detecting element 62 do not pass the switching element 63, and the On screen character display signals output from the microcomputer 4 are displayed on the Braun tube 67 through the switching element 63 and the video amplifying element 65. Consequently, the user may perceive that the code is set up.”<sup>42</sup>

Consequently, and ignoring *arguendo* that failure of the Examining staff’s proposed combination to present a *prima facie* showing of obviousness, this rejection is impermissible, and contrary to the probation against hindsight reconstruction of the art in light of the Applicant’s teachings, and it unnecessarily prevents the primary reference from operating in its intended mode of operation.

Withdrawal of this rejection is therefor required.

### **Claims 7 and 27**

Applicant’s claims 7 and 27 additionally defines, among its other features,

“storing the secret code as a lock code, clearing said screen of said prompts and said secret code display during the displaying step, and locking the on-screen display system when the determination indicates that the on-screen display system is **not in said lock state....**”

In contradistinction, the Examining staff’s proposed combination, as illustrated in Figure 3B of the primary reference, in the event that:

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<sup>42</sup> Rew ‘085, column 3, lines 24-31. In other words, the user is alerted to the fact that the code N1 has been set up by the absence of any image appearing on Braun tube 67 that corresponds to the video signals output from the detecting element 62, because those video signals do not pass switching element 63.

“no code N1 is set up, the microcomputer 4 directs normal operation of the system as in a conventional television set.”<sup>43</sup>

In other words, the Examining staff’s proposed combination operates in a manner that is expressly contrary to that defined by claims 7 and 27; this is however, but a single item of evidence that the Examining staff’s proposed combination fails to make a *prima facie* showing of obviousness. It is this feature of Applicant’s invention that advantageously enables the reliable prevention of surreptitious use of the video display device (*e.g.*, as by the output of a video tape recorder or DVD player, as opposed to the tuner of the television) by any unauthorized individual, in contradistinction to the Examining staff’s proposed combination. In summary, the Examining staff’s proposed combination fails to satisfy the third prong of the criteria for obviousness under MPEP §706.02 (j). The rejection is therefore untenable, and must be withdrawn. Such action is respectfully requested.

### Claim 28

Claim 28, defines:

“storing in a memory and displaying on said display screen in secret code sequentially input by a user using the key matrix in response to said prompts ... [and] storing the input secret code as a lock secret code, clearing the display and locking the video system when the lock state is determined to be in **said unlocked state...**”

This is contrary to the mode of operation of the Examining staff’s proposed combination which, as previously explained, proposes to substitute a power-on key for Applicant’s “lock key” and to respond to manipulation of that power-on key by using microcomputer for to direct “normal

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<sup>43</sup> Rew ‘085, column 3, line 6.

operation of the system as a conventional television set" when no code N1 is set up.<sup>44</sup> These deficiencies are not removed by the process for resetting a previously established code N1 to a new code N2 in the primary reference.<sup>45</sup>

The Examining staff fails to address this deficiency in the applied art, and consequently fails to demonstrate that the proposed combination teaches or suggests all of the claim limitations, as is required by MEPP §706.2 (j). The rejection of claim 28 must therefore be withdrawn.

### Claim 35

Applicant's claim 35 contemplates the microcomputer,

"controlling broadcast of all audio sounds ... through generation of a control output for **a period of time** defined by the first input of lock key data followed by the first input of the secret code and the second input of the lock key data followed by the second input of a secret code,"

in combination with:

"a mixer generating said video components by mixing said first video signal and said second video signal ... ."

In contradistinction, the Examining staff's proposed combination lacks any aspect of Applicant's "generation of a control signal for a period of time" in the manner implemented by the Applicant, which deleteriously exposes the mixer in the proposed combination to generation of video components, a result that is explicitly contrary to the teaching of the absolute denial of any and all

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<sup>44</sup> Rew '085, column 3, line 6.

<sup>45</sup> Rew '085, column 3, lines 43-55.

“unauthorized use of a television set” intended by Rew ‘085 so that

“any person who does not know the code [being] unable to drive the television set”<sup>46</sup>.

To assure the implementation of this intended absolute denial of any and all “unauthorized use of a television set”, Rew ‘085 “outputs an audio erasing signal so that no audio signal is output from the audio amplifying elements 64” under conditions of a set up of code N1. This, together with the fact that the Examining staff’s proposed combination is singularly devoid of Applicant’s “lock key data followed by import of the secret code” and instead proposes to substitute the power-on key therefore, is convincing *indicia* of an absence of obviousness and lack of *prima facie* demonstration of that obviousness. Withdraw of this rejection of claim 35 is therefore required.

### Claim 59

Even ignoring *arguendo* that absence in the Examining staff’s proposed combination of Applicant’s “key-data inputs signal received from the user **during a system power stand by mode of operation**” and Applicant’s identification of that key-data input signal “as being indicative of input said lock key”, the Examining staff’s proposed combination fails to make a *prima facie* showing of obviousness. Applicant’s claim 59 contemplates “storing the input code as a lock code ... and barring viewing of the video program via on-screen display system when the determination indicates that the on-screen display system is not in said lock state”; this is feature that is explicitly contrary to the intended mode of operation of both the primary reference and the Examining staff’s

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Rew’085, column 4, line 64.

proposed combination, but which advantageously contributes to Applicant's implementation of heightened security. This alone is convincing indicia of non-obviousness. Withdrawal of this rejection of claim 59 is therefore required.

**B. The rejection of claims 7, 9 through 19, 27 through 43 and 59 lacks a demonstration of motivation for making the Examining staff's proposed combination under 35 U.S.C. §103(a)**

Utterly devoid from the applied art is any evidence of motivation for modifying the primary reference to incorporate a mixer from the secondary reference; the primary reference performs according to its disclosed mode of operation wholly without a mixer. The primary reference has neither need nor generation of any video signals to mix. The fact of the matter is that on the evidence of record in this application, the Examining staff's proposed combination including Rew '085 has but a single video signal R,G,B generated by detecting element 62;<sup>47</sup> note that Rew '085 uses microcomputer 4 to generate “[t]he ON screen character display signals ... r,g,b... .”<sup>48</sup>

Nowhere does the Examining staff's proposed combination pretend that the *ON screen character display signals* output from the output terminals r,g,b of the microcomputer 4 are either video signals or are interchangeable with the *video signals* output from the output terminals R,G,B of the detecting element 62; any argument to the contrary by Paper No. 41 is technical fantasy unsupported by the art of record. Precisely what video signals is the Examining staff's proposed

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<sup>47</sup> Rew '085, column 2, lines 37 and 38.

<sup>48</sup> Rew '085, column 2, lines 34-41, “The *ON screen character display signals* output from the output terminals r,g,b of the microcomputer 4 or the *video signals* output from the output terminals R,G,B of the detecting element 62 are designed to be input to the video amplifying element 65 through switches S1-S3 of the switching element 63.”

combination intended to “mix” in “mixing circuit 8” of the Examining staff’s proposed combination when “microcomputer 4” simply supplies “On Screen Character display signals r,g,b to video amplifier 65? The sole basis of record for the Examining staff’s proposed modification is therefore, an impermissible reconstruction of the art in the light of Applicant’s teachings, as are set forth in the pending claims. Withdrawal of this rejection is thus required.

**C. The rejection of claims 7, 9 through 19, 27 through 43 and 59 fails to consider the “subject matter as a whole” as is required by 35 U.S.C. §103(a)**

35 U.S.C. §103(a) requires that “the subject matter as a whole” be considered in a determination of obviousness. Instead, the Examining staff has summarily made a piecemeal review of Applicant’s claims 7, 9 through 19, 27 through 43 and 59, by, among other deficiencies, ignoring the relation between Applicant’s structural and process features, and focusing upon partial aspects of the pending claims in a misguided effort to demonstrate obviousness under a point-of-novelty criterion. As one example of this discredited approach, in support of this approach to 35 U.S.C. §103(a), the Examining staff wrote in Paper No. 41 that:

“Rew discloses a method and system for controlling video ... of a television set having a standby mode of operation via the fact that a remote control receiver (3) is powered during standby to be responsive to a remote control unit (2) for subsequent powering up of the video system at turn on.”

Utterly ignored is the fact that the Examining staff’s proposed combination including Rew ‘085 is “responsive to a remote control unit (2) for subsequent simultaneously with powering up of the video system at turn on” because the Examining staff’s proposed combination has only “the power key of

the keyboard element 1 or remote control 2 ... ." In essence, Paper No. 41 has inaccurately characterized selected features of the proposed combination of the prior art in an effort to reconstruct Applicant's claims.

In another example, Paper No. 41 write that,

"[t]his power key input meets the scope of the claimed 'lock key' or 'lock key data',"

although the record is devoid of any evidence that the "power key input meets the scope of the claimed 'lock key' or 'lock key data'." Moreover, the response of the Examining staff's proposed combination to the "power key input", namely:

"the microcomputer 4 directs **normal** operation of the system as in a conventional television set. In other words, the microcomputer 4 controls the detecting element 62 by the remote control key signal of the keyboard element 1 or remote control 2 to select the television broadcasting signals, and the video signals of the selected broadcasting signals are displayed on the Braun tube through the switching element 63 and the video amplifying element 65, and the audio signals are output to the speaker 66 through the audio amplifying element 64."<sup>49</sup>

This behavior of the Examining staff's proposed combination is not what is described by the Examining staff in Paper No. 41; that is, the description set forth in Paper No. 41 is technically inaccurate. Where, for instance, is the teaching in the proposed combination of "the scope of the claimed 'lock key' or 'lock key data'?" There is not evidence of record to support this unusual characterization of the "power key of the keyboard element 1 or remote control 2."<sup>50</sup> Moreover, this

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<sup>49</sup> Rew '085, column 3, lines 3-16.

<sup>50</sup> Rew '085, column 2, lines 67 and 68.

mischaracterization of the teachings of the proposed combination is fiction. Furthermore, where are such features of Applicant's claims 7 and 28, by way of example, as:

"determining whether the lock state of said system is a locked state or an unlocked state after a last character of said secret code has been input;

storing the input secret code as a lock secret code, clearing the display screen and locking the video system when the lock state is determined to be in said unlocked state;

comparing the input secret code with a lock code previously stored in the microcomputer when the lock state is determined to be in said locked state...";

of claim 29, or

"a microcomputer responding to input signals selectively input from a keyboard or a remote control receiver by controlling display of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a first input of a secret code and a second input of said lock key data followed by a second input of a secret code;"

of Applicant's claim 35, or

"a microcomputer responding to input signals selectively input from a keyboard or a remote control receiver by controlling broadcast of audio sounds corresponding to said audio components through generation of a control output for a period of time defined by a first input of lock key data followed by a first input of a secret code and a second input of said lock key data followed by a second input of a secret code ..."?

Paper No. 41 is silent, and despite its unusual length, Paper No. 41 fails to address these, and other, aspects of the pending claims. I point of fact, nothing in the proposed combination responds in this manner to Applicant's lock key data. This piecemeal and incomplete approach to determinations of obviousness is unlawful under 35 U.S.C. §103(a); consequently, this rejection should be

withdrawn, and claims 7, 10, 27 through 43 and 59 allowed.

In view of the foregoing explanations and remarks, all claims are deemed to be in condition for allowance. Should any questions remain unresolved however, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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